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PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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In re Application of :
Christian Quellet et al :
Serial No.: 09/756,925 : PETITION DECISION
Filed: January 9, 2001 :
Attorney Docket No.: 102790.43 :

This is a decision on the petition under 37 CFR 1.144, filed May 2, 2003, by facsimile transmission, requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained claims 1-27. The examiner mailed a first Office action to applicants on August 29, 2001, rejecting all of claims 1-27 under 35 U.S.C. 112, second paragraph, for indefiniteness and under 35 U.S.C. 103(a) as unpatentable over van Lengerich in view of Saleeb et al and Bilbrey.

Applicants replied by canceling claim 1 and amending various other claims and arguing the rejections of record. The examiner mailed a Final Office action to applicants on April 10, 2002, rejecting claims 1-27 (sic 2-27) under 35 U.S.C. 103(a) as unpatentable over van Lengerich in view of Saleeb et al and Bilbrey and responded to applicants arguments.

Applicants filed an argument after Final rejection on July 9, 2002, which the examiner deemed unpersuasive in an Advisory action mailed July 25, 2002. A telephonic interview was conducted on September 9, 2002, but did not result in allowance of the claims. Applicants filed RCE papers on September 17, 2002 (Certificate of Mailing dated September 9, 2002), and an amendment and further response to the Final Office action. Claims 2-5, 11 and 25 were amended and claims 28-41 were added.

The examiner then mailed a new Office action to applicants on December 18, 2002, setting forth a restriction requirement as follows:

Group I, claims 2-10 and 28-41, drawn to compositions;
Group II, claims 11-27, drawn to a method of making.

The examiner reasoned that Groups I and II were related as process and product and that the product could be made in other ways and that the search for one group would not be required for the other group.

Applicants replied on January 15, 2003, electing Group I with traverse. Applicants argued that claims 25-27 should be included with Group I as they are essentially composition claims with a different preamble.

The examiner mailed a non-Final Office action to applicants on April 9, 2003, maintaining the restriction requirement for essentially the reasons previously set forth and making it Final. The examiner rejected claims 28-41 under 35 U.S.C. 112, second paragraph, as indefinite for lack of antecedent basis and claims 2-10 and 28-37 under 35 U.S.C. 103(a) as unpatentable over Carr et al in view of Tsuei et al, and claims 38-41 as unpatentable over Carr et al and Tsuei et al further in view of Bilbrey.

Applicants filed this petition on May 2, 2003, traversing the restriction requirement for various reasons and filed a full reply to the Office action on July 7, 2003.

DISCUSSION

Applicants argue that the restriction between Groups I and II is improper. Applicants first note that in the first two Office actions prior to the filing of RCE papers no restriction requirement on the same claims or same inventions was made. The subject matter of the claims now divided into two groups was examined together in previous Office actions by the same examiner. Thus there appears to be no serious burden on the examiner to examine both inventions at the same time.

Applicants further argue that claims 25-27 should be included, at a minimum, in Group I since they are also to a composition, the claim preamble being the only difference wherein a "system" comprising a composition rather than just a "composition" is recited. Thus the claims have an essentially identical scope.

Applicants' arguments are well taken. Consistency and compactness in prosecution are desirable in the Office. Thus to now separate into different groups claims which were previously examined together, without a good reason for doing so, is not considered consistent nor compact prosecution. In addition, claims of a similar scope, such as claims 25-27 and claims 2-10 and 28-41, should be examined together for the reason noted above. In view of applicants' arguments the restriction requirement is withdrawn.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED**. Claims 2-41 will all be examined.

The application will be forwarded to the examiner for further prosecution, including consideration of the amendment filed July 7, 2003, not inconsistent with this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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